

REMARKS

Claims 1-2 and 5-19 are pending in the subject application, wherein Claims 7-9 and 12-17 have been withdrawn from consideration by the Examiner for being directed to non-elected subject matter. Applicants respectfully submit that no new matter is presented herein.

In view of the Final Office Action dated January 10, 2006, the April 20, 2006 dated Response thereto, and the Advisory Action dated May 2, 2006, Applicants respectfully submit that this Submission, which is supplemental to and to be taken into consideration with the Response dated April 20, 2006, places the instant application in condition for allowance.

Prompt and favorable examination on the merits is respectfully requested.

Applicants Response to Examiner's Assertions

The Final Office Action dated January 10, 2006 rejected Claims 1-2, 5-6, and 18-19 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 5,691,876 to Chen et al. (Chen) and Claims 10-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chen. In the Response filed April 20, 2006, which has been entered by the Request for Continued Examination filed in conjunction with the instant Submission, Applicants amended Claim 1 as follows:

... an adhesion between the aluminum alloy metal substrate and the first insulation layer is performed by using a thermoplastic polyimide-based adhesive film having a film thickness of 5 to 50 μm and ~~by subjecting the thermoplastic polyimide-based adhesive film to a~~ capable of withstanding low-temperature compression bonding ~~processing under pressure~~ at a temperature of 100 to 250°C.

The Advisory Action dated May 2, 2006 asserts the feature "capable of withstanding" is considered new matter because there is no adequate support for the feature anywhere in the originally filed specification. The Advisory Action notes that while the specification provides support for the step of low-temperature compression bonding processing being performed at a temperature of 100°C to 250°C under pressure to form a laminate structure, the Advisory Action asserts the specification fails to provide support for the adhesive film *specifically* being "capable of withstanding" low-temperature compression bonding.

Applicants respectfully submit the assertion that the amendments to Claim 1 introduce new matter is erroneous for at least the reason(s) set forth below.

As outlined in M.P.E.P. §2163.04, the inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. See *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description.

Applicants respectfully note that in the instant application, the Examiner has not fulfilled the initial burden of presenting, by a preponderance of evidence, why a person skilled in the art would not recognize in the Applicant's present application a description of the invention defined by the pending claims. See *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. Moreover, the Examiner also failed to set forth express findings of fact which

support the lack of written description conclusion, such findings are required to include the claim feature at issue (Applicants note this requirement was met in the Advisory Action); and establish a *prima facie* case by providing reasons why a person skilled in the art would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.

Moreover, the Examiner takes the position that the proposed amendments to Claim 1, wherein the claim was amended to recite the adhesive film is "capable of withstanding" low-temperature compression bonding, lacks support in the originally filed application, apparently because the words "capable of withstanding" are not *specifically* contained in the specification as originally filed.

Applicants are unaware of any statute, rule or procedure under U.S. Patent law and/or the M.P.E.P. which requires that patent applicants are required to use only those terms *specifically* disclosed in the specification in the claims of a patent application.

While Applicants concede the phrase "capable of withstanding" does not specifically appear in the specification as originally filed, Applicants respectfully disagree with the Examiner's position that amending Claim 1 to recite such a phrase constitutes introduction of new matter. Applicants respectfully submit that the amendments to Claim 1 merely rephrase an inherent feature that which was disclosed in the application and recited by the claims as originally filed.

Applicants respectfully remind the Examiner that the mere rephrasing of a passage does not constitute new matter. See M.P.E.P. §2163.07 (I). Put in simple terms, the rewording of a passage where the same meaning remains intact is permissible. See *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

Furthermore, Applicants respectfully remind the Examiner that amending the claims to recite, more clearly, a feature that is inherently provided or presented therein does not constitute new matter. See M.P.E.P. §2163.07(a), which clearly states that by disclosing in a patent application a device that inherently performs a function, has a property, operates according to a theory, or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. In view of such, the application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. See *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); and *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973).

In the instant application, Claim 1 previously recited that adhesion between the aluminum alloy metal substrate and the first insulation layer was performed by using an adhesive film having a thickness of 5 to 50 μm and by subjecting the adhesive film to a low-temperature compression bonding process under a temperature of 100 to 250°C. The April 20 Response amended Claim 1 for clarification purposes to recite the inherent feature that adhesion between the aluminum alloy metal substrate and the first insulation layer was performed by using an adhesive film having a thickness of 5 to 50 μm and that is capable of withstanding a low-temperature compression bonding process under a temperature of 100 to 250°C. The April 20 Response reproduced the entire paragraph, i.e., paragraph [0022], from the originally filed application, which the Applicants submit is an exemplary passage in the originally filed application which provides support for the amendments to Claim 1. See page 9 of the April 20 Response.

Applicants respectfully submit that an adhesive film which "can be subjected to" low temperature compression bonding, as is stated in originally filed paragraph [0022] of the application, inherently is an adhesive film "which is capable of withstanding" low temperature compression bonding, as is recited in the amendment to Claim 1 of the April 20 Response.

Furthermore, Applicants respectfully submit that a person of ordinary skill in the art to which the claimed invention pertains would readily understand that an adhesive film that is "subjected to a low-temperature compression bonding process" inherently is "capable of withstanding" the same low-temperature compression bonding process.

Applicants respectfully note that in the instant application, the Examiner has not fulfilled the initial burden of presenting, by a preponderance of evidence, why a person skilled in the art would not recognize in the Applicant's present application a description of the invention defined by the pending claims. Moreover, Applicants respectfully submit that the Examiner has also failed to establish a *prima facie* case that the amendments to Claim 1 introduce new matter because the Examiner has yet to provide any reasons as to why a person skilled in the art would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as originally filed.

In view of the above, Applicants respectfully submit that the amendments to Claim 1 do not present new matter and that Claim 1 is allowable for the reasons provided in the April 20 Response.


Conclusion

For all of the above reasons, reconsideration of the application, withdrawal of the outstanding rejections, allowance of Claims 1-2 and 5-19, and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 101160.00026.**

Respectfully submitted,



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